IN THE

UNITED STATES SUPREME COURT,

OCTOBER TERM, A. D. 1880.

No. 1086.

LAKE SHORE & MICHIGAN SOUTHERN RAILWAY COMPANY,
Appellant,
—vs.—
NATIONAL CAR BRAKE SHOE COMPANY,
Appellee.

Appeal from the United States Circuit Court, for the Northern District of Illinois.

BRIEF AND ARGUMENT FOR APPELLANT.

GEORGE PAYSON,
For Appellant.

BEACH, BARNARD & CO., LEGAL PRINTERS, 104 RANDOLPH STREET.

IN THE

UNITED STATES SUPREME COURT,

OCTOBER TERM, A. D. 1880.

No. 1086.

LAKE SHORE & MICHIGAN SOUTHERN RAILWAY COMPANY,
Appellant,
—vs.—
NATIONAL CAR BRAKE SHOE COMPANY,
Appellee.

Appeal from the United States Circuit Court, for the Northern District of Illinois.

BRIEF AND ARGUMENT FOR APPELLANT.

This is a suit in equity on Letters Patent for Improvement in Shoes for Car Brakes, issued October 6, 1863, to James Bing, and assigned by him to appellee; said improvement consisting, mainly, in so combining the parts as to give the "sole" a lateral rocking motion upon the body of the shoe. It is a test suit brought to determine, not only the liability of the present defendant, but that also of other roads, and for larger amounts, for the alleged infringement of the same patent by the use of brake-shoes of the same general character as those here in question. Hence this appeal.

There are two claims in the patent; but, it having been stipulated that there is no infringement of the first claim, the second claim only will have to be considered in this case. This claim, if construed as it is by the appellant, is admitted to be valid;

but appellant denies its validity on the construction given to it by the appellee.

Two different kinds of brake-shoes are in proof, as having been used by the appellant, both of which are alleged by the appellee to be infringements, but as to both of which, infringement is absolutely denied. The question of infringement as to the first of these shoes depends solely on the construction of the claim; while as to the second shoe, it is necessary also to consider whether it is substantially the same as that described in the patent.

The Circuit Court held both these shoes to be infringements of said second claim, and the parties having waived the usual reference to the master, and agreed upon the amount of damages, a final decree was entered in complainant's favor for two hundred dollars, from which the defendant appealed to this court, and the case is now submitted on printed briefs under the Twentieth General Rule.

All the evidence is comprised in the stipulation and models therein specified, and the complainant's patent.

The questions arising in the case are few and simple:

1. Is the construction put upon the second claim of the patent by the Circuit Court the true one?

2. Is either of defendant's brake shoes an infringement of said claim when properly construed?

3. Is not said claim, if construed as it was by the Circuit Court, void for want of patentable novelty?

4. Is the brake shoe, shown in the model marked "*Defendant's Exhibit B*," substantially the same in its mechanical construction as that found in said claim?

It is charged by appellant that the Circuit Court erred.

1. In its construction of the second claim of said patent, in finding that it did not include the lateral rocking motion described in the specification.

2. In not finding said claim on that construction void for want of patentable novelty.

3. In finding that the first of defendant's brake-shoes infringed said claim.

4. In finding that the second of said shoes, "*Defendant's Exhibit B*," infringed said claim.

5. In finding that said shoe last mentioned was substantially the same in its mechanical construction and arrangement as that found in said claim.

6. In entering a decree in favor of complainant.

7. In not entering a decree in favor of defendant.

Brief of Argument for Appellant.

I.

The first and most important question relates to the construction of the second claim of the complainant's patent, the only claim here alleged to be infringed.

The patentee states in his specification that his "invention relates to the construction of shoes or rubbers for car wheels, and consists, *firstly*, in constructing the shoe of two parts, in the peculiar manner described hereafter, so that the part in contact with the wheel can accommodate itself to the same; and, *secondly*, in the peculiar combination described hereafter of the two parts of the shoe, the clevis by which the shoe is suspended to the truck, and the bolt which secures the clevis to the shoe, and the two parts of the shoe to each other."

Then follows, as usual, the more detailed description of the invention. It is a brake-shoe made in two parts, one part, which may be called the shoe proper, being attached to the brake beam in the ordinary way, and the other part, which is called the sole, being attached loosely to the first part by interlocking lugs, in a manner readily understood from the models.

There are two of these models in the case, the small brass model offered by the appellee, and marked "*Complainant's Exhibit Bing's Brake Shoe*," and the black wooden model offered by appellant, and marked "*Defendant's Exhibit A.*" Both of these models are admitted to be correct representations of the patentee's device, except that complainant's model is claimed by defendant to have too little rocking motion; while, on the other hand, the defendant's model is claimed by complainant to have too much.

No model is presented of the first of the defendant's shoes, for the reason that that shoe is admitted to be the same as the patentee's, except that the parts are so fitted together as to have no rocking motion, and no question as to its mere mechanical construction can therefore arise.

Defendant's second shoe, however, is alleged to be substantially different from the patentee's in its mechanical construction,

and hence a model of that shoe is here offered, marked "*Defendant's Exhibit B.*"

The third model, "*Defendant's Exhibit C,*" represents a brake shoe in use before the patentee's invention, and is here offered simply to show the state of the art.

The fourth model, "Defendant's Exhibit D," is not offered as proof, but simply by way of illustration.

The patentee having described the construction of his brake-shoe, as above stated, then goes on to set forth the object and advantages of that construction:

"The peripheries of car wheels are always beveled or inclined, so that it becomes necessary to make the soles of the ordinary shoes or rubbers of a corresponding bevel, one shoe at one end of the beam being beveled in one direction, and the other shoe, at the opposite end of the beam, being beveled in a contrary direction. Even when the usual shoes are properly fitted to the beveled peripheries of the wheels, the lateral movement of the axles, as the wheels traverse curves of the track, is such that the ordinary shoes cannot fit accurately at all times. Another evil attending the use of ordinary shoes or rubbers is, that, as the lateral movement of the axle takes place, an undue strain is imparted to the brake beam. These difficulties are avoided by my invention, inasmuch as the sole B is permitted to have a lateral rocking motion on the shoe, and can at once accommodate itself to the bevel of the wheel, or to any variation caused in that bevel by the lateral movement of the axle."

The brake shoes previously in use had either been made solid, that is, all in one piece, or else in two parts, with the sole attached to the shoe by bolts, as in the model "*Defendant's Exhibit C.*" The first of these could have, of course, no rocking motion; while, in the second, only an inconsiderable amount of such motion would ever be possible. Hence they were unable to accommodate themselves to the beveled surface of the wheel, except to a slight degree, and thus often wore very unevenly, shoes an inch in thickness being sometimes worn down on one side to a thin edge, while on the other side they would remain as thick as ever.

This evil the patentee's shoe was designed to cure. To this end the two parts had to be connected so loosely as to allow the sole freely to rock upon the shoe. To admit of this, the lug at

the upper end of the sole is to be made tapering, so as to move easily from side to side between the two lugs upon the shoe. And the bolt that fastens the shoe and sole together, must also, for the same reason, be made of a less diameter than the holes in the lugs.

Theoretically this was of some value, and was doubtless so regarded by the patentee at the time of his invention; though, as is often the case, actual trial brought out certain practical disadvantages, such for instance as the increased noise and rattling, which have probably interfered very considerably with its success.

The second claim reads as follows: "The combination of "shoe A, sole B, clevis D and bolt G, the whole being con- "structed and arranged substantially as specified."

And the question is, whether this claim includes the lateral rocking motion described in the body of the specification, or, in other words, whether the *shoe*, and *sole*, and *bolt* can be said to be constructed and arranged "substantially as specified," if so constructed and arranged as not to permit of this motion.

If this last be the true construction—if the lateral rocking motion forms no part of this second claim, then it is admitted that the *first* of defendant's shoes is an infringment. But if this lateral rocking motion does form a part of said claim, then again it is admitted that there is no infringment as to *either* of defendant's shoes. The court below held that the claim did not include the rocking motion, and this is the first error assigned by the appellant.

But for this decision it would seem that, in view of the repeated rulings of this court, there could be no difference of opinion as to this question. To say that the shoe, and sole, and bolt are constructed and arranged substantially as specified, when the chief substance of that construction and arrangement is wanting, seems a contradiction in terms. The language of the claim is unusually clear and explicit. The several parts are all referred to by name and by letter, as shoe A, sole B, clevis D, and bolt G. And the *whole* is to be constructed and arranged substantially as specified.

If then, we turn to the specification to see what "substantially "as specified" means, we find the shoe, the sole, and the bolt all fully and expressly described as so constructed and arranged as to give the sole a lateral rocking motion upon the shoe. We find the peculiar merits and advantages of this mode of construction fully set forth and insisted upon. We find, in short, that this rocking motion is of the very essence of the invention, the main thing that the patentee was seeking after.

On the other hand, we wholly fail to find a word to indicate or suggest that the patentee ever thought of making his shoe, and sole, and bolt in any other way, that is, without the rocking motion. If he did think of it, if it was his intention then to claim a brake shoe constructed and arranged in other respects as described in his specification, but without the rocking motion, it was his duty to say so. He should have stated that, though he deemed the above mode of construction, that having the rocking motion, preferable, yet he did not intend to confine himself to it, but that a shoe and sole constructed in other respects in the same way, though without the rocking motion, would be equally within the patent. And his claim should have corresponded. "I claim the combination of shoe A, sole B, clevis D, and bolt "G, &c., whether with or without the rocking motion."

Then the public would have known precisely what it was he meant to claim. As the matter stands now, any one, it seems, on reading this claim in connection with the specification, would say at once that the several parts mentioned could not be held to be constructed and arranged substantially as specified unless they had the rocking motion.

If, however, there is any ambiguity, it is suggested that the patentee is the one who ought to suffer by it. There was no need of any ambiguity. There is nothing complex about the invention, nothing to prevent its being described and claimed with absolute precision. And that it is the duty of the patentee thus to word his claims has been often decided by this court.

Thus, in *Merrill* v. *Yeomans*, 94 U. S., 573, the court say: "The public should not be deprived of rights supposed to be- "long to it without being clearly told what it is that limits

" those rights..... It seems to us that nothing can be more " fair and just, both to the patentee and to the public, than that " the former should understand and correctly describe just what " he has invented, and for what he claims a patent."

" The courts have no right to enlarge a patent beyond the " scope of its claim, as allowed by the Patent Office, or the ap- " pellate tribunal to which contested applications are referred. " When the terms of a claim in a patent are clear and distinct " (as they always should be), the patentee in a suit brought upon " the patent is bound by it. He can claim nothing beyond it. " *Keystone Bridge Co.* v. *Phœnix Iron Co.*, 95 U. S., 278.

" A combination is always an entirety. In such cases the " patentee cannot abandon a part and claim the rest; nor can " he be permitted to prove that a part is useless, and therefore " immaterial. He must stand by his claim as he made it. " *Schumacher* v. *Cornell*, 96 U. S., 554.

" Courts should be careful not to enlarge by construction " the claim which the Patent Office has admitted, and which the " patentee has acquiesced in, beyond the fair interpretation of " its terms." *Burns* v. *Meyer*, 100 U. S., 672.

It will be urged, however, of course on the part of the appellee, that the rule laid down in the above cases has been strictly followed by the Circuit Court; that there is no ambiguity in the claim, and that the construction put upon it is one fairly and plainly deducible from the specification. The argument in support of that view is briefly this:

" There are two distinct and independent improvements described in the specification, first, the lateral rocking motion; and, second, the 'peculiarly simple arrangement of the clevis which supports the shoe; the bolt G serving the purpose of connecting the clevis to the shoe, and the latter to the sole.' And so, in like manner, there are two distinct and independent claims, one for the first of these improvements, and one for the other. If the rocking motion is to be included in the second claim, what need was there of two claims, and why does the patentee, in his first claim, expressly name the rocking motion, while he makes no mention of it in his second claim? The patentee might have had a claim for his arrangement of the clevis by itself, and therefore, *ut res magis valeat quam pereat*, his second claim should be so construed as to give him the full benefit of his invention. And

finally, the parts in the first claim are '*adapted*' to each other; in the second they are only '*constructed and arranged.*' "

In reply to this, it is suggested on behalf of the appellant,

First. That there is nothing in the specification to indicate that these two improvements are thus independent, or that the patentee ever thought of using one without the other. On the contrary, they are both treated as parts of the same invention. The main invention was the rocking motion, to which the "peculiarly simple arrangement of the clevis" was purely incidental.

Second. The fact that the patentee has annexed two claims to his specification, can have no significance in this connection, until it is shown that the second claim on the appellant's construction has no use or meaning. But this is far from being the case. This claim was added from extra caution, as is constantly done in similar cases by every careful lawyer in drawing such papers. The first claim is general, the second more specific. The first claim includes only a part of the different elements of the combination; the second includes them all. The first is for the rocking motion alone; the second is for the same with the clevis arrangement added. Hence, the first claim might be defeated for want of novelty, and the second still be sustained.

Third. As to the rocking motion being expressly named in the first claim, and not in the second, it is not seen how that can make any difference. The first claim would certainly have had precisely the same meaning if the words "rocking motion" had been omitted. Exact uniformity of language is seldom or never found in such instruments, and the words here used in the second claim are quite as strong as those in the first. In the first claim we are told that the rocking motion is to be included; in the second claim *the whole* is to be constructed and arranged substantially as specified. If any argument, therefore, is to be drawn from the wording of these claims, it would seem rather to be in favor of appellant.

Fourth. As to the words "*constructed and adapted,*" in the first claim, and the words "*constructed and arranged,*" in the second, on which so much stress is laid by the appellee, we can only say that to find any one guilty on such a nice philological

distinction seems abhorrent to every sense of justice, and to the whole spirit of our laws.

Fifth. As to construing the second claim so as to give the patentee the full benefit of his invention—*ut res magis valeat quam pereat*—it is a mistake, as already shown, to assume that the patentee, on appellant's construction, has no claim for his clevis connection. He has a claim for it in combination with the rocking motion. If he wanted more than that—if he wanted the clevis connection by itself—he should have said so.

The whole question then reduces itself to this: Has he said so? Is it possible, on any fair and reasonable construction to give that meaning to his second claim? Is it fair or just to require the public to go through such a refined and subtle process of reasoning in order to find out what is really meant by the claims of a patent? If so, it would seem that in drawing such claims, words are to be used only to conceal ideas. The claim then becomes a curious puzzle, framed purposely to mislead, seeming to mean one thing, but really meaning another wholly different.

In short, this whole argument of appellee is based on the false assumption that the patentee's two improvements are described in his specification as entirely separable from each other, instead of being described simply as parts of a single whole. To read that argument, one would suppose that the only connection between these improvements was, that they both related to a brake shoe, and not to the same parts of the shoe, but to separate parts. And yet nothing can be more certain than that all the parts mentioned in the second claim, with the exception of the clevis, are identically the same parts as those found in the first claim. There is no such distinction in the description of these parts as that so artfully presented throughout the appellee's brief. It is all one description. There is but one description in the specification for the shoe, the sole and the bolt, and yet the court is asked to find that this single description has these two entirely distinct and antagonistic meanings.

How, we ask again, was the public to know that the very same words which, when applied to the first claim, mean a loose

or rocking connection, when applied to the second claim, mean a rigid connection?

Sixth. So far from this second claim being in any sense defeated by the appellant's construction, that would seem rather the only way to save it. With the rocking motion included, it may be admitted that there is sufficient patentable invention to maintain the claim. The rocking motion was new, and subject to the objections above named, was certainly useful. But with the rocking motion excluded, there is nothing left; nothing, that is, but the mere mechanical construction, in which it is hard to see how there can be any invention.

In considering this question, a difficulty arises from the manner in which this part of his improvement is described by the patentee. From the final clause in his specification, just preceding the claims, it would seem that this so called invention consisted simply in attaching the clevis to the same bolt that unites the sole to the shoe.

"Another improvement," he says, "in my invention, is the "peculiarly simple arrangement of the clevis which supports the "shoe; the bolt G serving the purpose of connecting the clevis "to the shoe, and the latter to the sole."

If this be the meaning, nothing could be more trivial. Attaching the clevis to the bolt that holds the sole to the shoe, so far from being an improvement, is a step backward. It is not nearly as convenient as the old mode of attachment, shown in the model "*Defendant's Exhibit C*," in which the clevis was attached to the shoe alone. In Bing's device, in order to remove the sole it is necessary first to detach the clevis; whereas, if the clevis were attached to the shoe alone, the sole could be removed without disturbing the clevis. This is clearly shown in model, "*Defendants Exhibit D*," which is here offered, not in proof, but simply as an illustration of the argument.

If, however, the second claim is said by the appellee to be for the mode of attaching the sole to the shoe, then again it is denied that there was any invention in that. All that the patentee did in that case—the rocking motion of course being now excluded—was to substitute one well known mode of at-

tachment for another equally well known. Brake shoes were already known in which the sole was fastened to the shoe by the ordinary screw-bolt. Bing simply threw away the bolts, and adopted the lug and pin. But the same mode of attaching two things together is found in the frame of a common slate, in fire tongs, in the dividers or compasses used by draftsmen, and a hundred other articles almost equally familiar. The common folding rule, used by carpenters for at least forty years, has its parts attached to each other in the same way, that is, by a lug on one of the parts, fitting in between two lugs on the other part, and both parts being then held firmly together by a pin passing through the three lugs. Moreover, this same "*rule*" has the precise equivalent of the lower lug on the sole of the Bing brake shoe, viz: the pin or peg projecting from one of the parts, and fitting into a socket on the other part, to keep them in line, or, in the words of the plaintiff's patent, "to maintain the two parts in their proper relative position."

What, then, is the application of this mode of attachment to a brake-shoe but a plain example of a double use? And how can this second claim be sustained, except on the appellant's construction making the rocking motion a part of it?

It is urged, however, by the appellee, that the appellant, having used this brake-shoe without the rocking motion, is estopped from denying its novelty and utility; that this shoe "has come into most extensive use, and may be seen, specifically or in slightly modified forms, on almost all the railroads in the United States, in many cases under the license of the patentee. And that no better evidence of the advance in the art made by Bing's invention could possibly be produced than the crude and clumsy contrivance resurrected by appellant, and which the ~~pre-~~ patented ~~tended~~ shoe has displaced."

It would be a sufficient reply to this to say that there is no evidence of it in the record; but that is not all, there is no foundation for it in fact.

This "crude and clumsy contrivance" was not "resurrected by appellant." It has not been displaced by Bing's invention. It is to-day in extensive use, and may be seen, specifically or in slightly modified forms, not on almost all the railroads in the

United States, but on a large number of them, probably on nearly or quite as many as the Bing.

If the extensive use of a thing, therefore, is evidence of its superior utility, then this so called crude and clumsy contrivance has equal claims to that distinction, and the argument of appellee falls to the ground. But the truth is, this argument, though sometimes sound, has here no application. There are, probably, at least fifty different kinds of brake-shoes in use, on the different railroads in the United States. As many as six or seven different kinds are sometimes found on the same road. The particular kind in use is almost always largely a matter of accident. Some kind of brake-shoe must of course be had, but the particular kind is not important. There are at least twenty kinds, one of which is as good as another. The master mechanic of a railroad is in want of a brake shoe; he sees one on another road that will answer the purpose, and has his own made the same way,—not because of any special merit in the shoe, but simply because he thinks "it will do."

Finally, the long delay of the patentee in presenting these claims against the different roads should not be lost sight of. The patent was granted in October, 1863, and has now expired. After many years of inactivity, it falls into the hands of its present owners, who, finding it too late to expand the claims in the usual way, by a re-issue, are now seeking to accomplish the same purpose by the highly metaphysical mode of reasoning already commented on. It seems a not unreasonable explanation of this delay to suggest that the construction now sought to be put upon the patent did not originate with the patentee, but was first invented in these latter days by the same ingenious counsel who have argued the case so ably in this court.

II.

If either of the above points is decided in favor of the appellant, that is, if the court shall be of the opinion that the rocking motion forms a part of the second claim, or that said claim, if so construed as not to include said motion, is invalid for want of

patentable invention, then, according to the stipulation, neither of the brake shoes in question can be held an infringement of the patent.

But if the court shall come to the conclusion that said rocking motion forms no part of said second claim, and also that said claim can be sustained on that construction, then it is admitted that defendant's *first* brake shoe is an infringement; but in order to find infringement as to defendant's *second* brake shoe, that shown by the model "Defendant's Exhibit B," it will still be necessary to consider the other question in the case, viz: whether this shoe is, in its mechanical construction, substantially the same as that shown in the patent.

In considering this question, it must be remembered that Bing is not an original inventor; but an improver only. He was not the first to invent a brake shoe, nor the first to invent a brake shoe with a detachable sole. All he did was to substitute for the mode of attachment already in use, as shown in the model "Defendant's Exhibit C," the mode shown in his patent. That is, he substituted for the well known bolts and screws the equally well known lugs and bolt or pin, as found in the slate frame and compasses above referred to. The rocking motion, of course, must here be left out of view, for it is only on the assumption that this motion forms no part of the claim that any infringement is pretended.

Being thus an improver only, and an improver, too, of this very slight degree of merit, he is not entitled to the benefit of equivalents, but can only charge as infringers those who have been guilty of a mere colorable invasion of his invention.

McCormick v. *Talcott*, 20 How., 404.

Now, the differences between the "defendant's Exhibit B" and the brake shoe described in the patent, are very far from being merely colorable. These differences exist not only in the form of the parts, but in their arrangement and combination, and in their mode of operation.

1. In Bing's brake shoe, as is apparent on inspection, the shoe and sole are held together by the bolt passing through holes in

all three of the upper lugs. It is impossible to remove the sole without first removing this bolt. But in the defendant's brake shoe, the lug on the sole is of a very different shape; it has no bolt hole for the bolt to pass through, nor anything corresponding to it, but instead it has a horn or shoulder adapted to receive the clevis. It is not the bolt that holds the defendant's shoe and sole together, but this purpose is effected in a very different way.

If the court will take the trouble to remove the clevis from the model "Defendant's Exhibit B," and then put in the bolt alone, it will be seen at once that the sole is no longer held in position, but can be readily withdrawn. And if a clevis like Bing's were then added, it would still be the same. There would be nothing, in that case, to keep the sole from falling out, and the device would be wholly impracticable. To make the sole in defendant's shoe secure, it is necessary to add the clevis in the peculiar manner shown in the model, that is, embracing the bolt between the two lugs on the shoe, instead of outside, as in the Bing. And to enable the clevis to perform this function, it is still further necessary to make the lug in the special manner shown in the model, that is, with a shoulder to fit the clevis.

Again, if now we take the sole of Bing's brake-shoe, and endeavor to attach it to the defendant's shoe in the same way, it will be found impossible. The shape of the lug does not permit it. There is no shoulder on the lug to fit defendant's clevis.

It seems impossible to maintain that parts so different as these are constructed and arranged in substantially the same way, much less that one is a mere colorable invasion of the other. Defendant's bolt, in fact, is not combined with the sole at all until the clevis is added; it takes both the bolt and clevis to do what is done in the Bing by the bolt alone; or rather the defendant's bolt and clevis together cannot do what is done by Bing's bolt; that is, they cannot, either alone or together, be used to attach Bing's sole to the shoe.

Again, this being a combination patent, it was incumbent on the plaintiff to prove that the parts substituted by the defendant in place of those shown in the patent were well known as proper substitutes therefor at the date of Bing's invention.

Gould v. *Rees*, 15 Wall., '194; *Gill* v. *Wells*, 22 Ib., 28, 32; *Imhaueser* v. *Buerk*, 101 U. S., 656.

The same has long been the rule in England. *Stevens* v. *Keating*, 2 Web. Pat. Cases, 188; *Heath* v. *Unwin*, Ib., 227, 241, 244. And in the House of Lords. Ib., 302, 314.

And the burden of proof is here upon the plaintiff. *Tafts* v. *Boston Mach. Co.*, 8 Off. Gaz., 240. SHEPLEY, J., 1875.

The only reply made to this by appellee is, that the doctrine of equivalents does not apply; that no parts are substituted in appellant's shoe,—but exactly the same parts are used as in the patented invention, viz., a shoe, a sole, a bolt, and a clevis.

If this argument is sound, then every brake-shoe, having a shoe, sole, bolt, and clevis, would be an infringement, no matter how different in form and arrangement.

Then, too, it would follow that the patent is invalid, for the brake-shoe, "Defendant's Exhibit C," has all these parts.

But, furthermore, even admitting that defendant had used all the same parts, that alone does not constitute infringement, but they must be arranged and combined in substantially the same way.

Prouty v. *Ruggles*, 16 Peters., 341.
Carver v. *Hyde*, *Ib.*, 513.
Stimpson v. *Railroad*, 10 How., 345.
Eames v. *Godfrey*, 1 Wall., 80.
Seymour v. *Osborne*, 11 *Ib.*, 555.

Second. The Court will also notice a marked difference between the lug at the bottom of defendant's shoe and that shown in the patent, both in form and result. The lug shown in the patent is pyramidal, and much higher than its corresponding socket, for the express purpose, as is stated, of permitting the sole to vibrate laterally in the said socket; while the defendant's lug is semicylindrical and not so high as its socket, not permitting any such motion. But as the rocking motion is excluded from this branch of the argument, and as we do not know how Bing would have arranged these parts in the supposititious shoe since invented for him by the complainant, there is perhaps nothing to be gained by pursuing this subject farther.

It needs only to be suggested in conclusion, that if the court should finally be in doubt as to any of the points here presented, that doubt should be resolved in favor of appellant. *Many* v. *Sizer*, 1 Fish., 22; *Cahoon* v. *Ring*, Ib., 403; *Brooks* v. *Jenkins*, 3 McLean, 432; *Washburn* v *Gould*, 3 Story, 142.

Respectfully submitted.

GEORGE PAYSON,
Counsel for Appellant.

110-229

110-229

Supreme Court of the United States.

SUPREME COURT U.S.
NOV 24 1880
JAMES H. McKENNEY, Clerk.

OCTOBER TERM, A. D. 1880.

THE LAKE SHORE & MICHIGAN SOUTHERN RAILWAY COMPANY, *Appellant.*

No. 1,086. *vs.*

THE NATIONAL CAR BRAKE SHOE COMPANY, *Appellee.*

Appeal from the U. S. Circuit Court, Northern District of Illinois.

Brief and Argument for Appellee.

EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Appellee,

W. R. ALEXANDER, LEGAL PRINTER, 148 MADISON ST.
CHICAGO.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1880.

THE LAKE SHORE & MICHIGAN SOUTHERN RAILWAY COMPANY, *Appellant.*

No. 1,086. *vs.*

THE NATIONAL CAR BRAKE SHOE COMPANY, *Appellee.*

Appeal from the U. S. Circuit Court, Northern District of Illinois.

Brief and Argument for Appellee.

MAY IT PLEASE THE COURT:

This is a bill in equity, brought by appellee against appellant, for infringement of patent No. 40,156. issued October 6, 1863, to James Bing, for an improvement in shoes for car brakes. The defense, insisting on a very narrow construction of the patent, contends that no infringement is shown. The case depends on the construction to be given to the second claim of the patent, to which the contention is limited by agreement. And such construction must be determined from

a consideration of the patent itself, inasmuch as nothing shown by the previous state of the art can operate to limit the invention further than the patentee's own specification and claims.

In arriving at a true construction of the patent, it will be necessary to consider the specification and claims at length; hence it is unnecessary in this place to more than briefly notice the several parts composing the patented combination. The part called the "sole" and designated by the letter B in the specification, rubs against the car wheel when the brake is applied, and produces the retardation. The part called the "shoe," and designated by the letter A, is bolted to the brake beam, and forms a back or support for the sole. These two parts, in the combination securod by the second claim, are held together by a bolt, G, which also serves the purpose of connecting the shoe to the lower end of the hanger or clevis, D; and the whole is suspended from the truck of the car by this clevis.

The contention of appellee is, that the patentee invented two distinct improvements, one of which is secured in each claim of the patent, and that the "lateral rocking movement" of the first claim is not required in the combination secured by the second claim. On the other hand, appellant contends that such lateral rocking movement is a feature of the second claim, and hence that it must be found in its brake shoes before they can be held to be infringements. In the Court below, Judge Drummond adopted the construction contended for by appellee, and held that "the second claim may be infringed "although there may not be in an infringing machine the lat- "eral rocking motion described in the first claim."

CONSTRUCTION OF THE PATENT.

It is a familiar rule of construction that a patent, as well as any other written instrument, must be construed so as to carry out the intention of the parties, whenever this is possible; hence it will be sufficient to inquire what the patentee

intended to secure by his second claim, and whether his language is sufficient to effectuate that intention. And, as said by Judge Drummond, "in considering the invention we "must give effect to the *whole* of the description contained "in the specification and claims."

To fully understand the invention and determine the intention of the patentee, and whether his language is sufficient to sustain Judge Drummond's construction of the patent, it will only be necessary to examine the specification and claims. The patentee thus describes his improvements in the specification :

"My invention relates to the construction of shoes or rub- "bers for car wheels, and consists—

"Firstly—In constructing the shoe of two parts in the "peculiar manner described hereafter, so that the part in "contact with the wheel can accommodate itself to the same.

"Secondly—In the peculiar combination described here- "after of the two parts of the shoe, the clevis by which the "shoe is suspended to the truck, and the bolt which secures "the clevis to the shoe, and the two parts of the shoe to each "other."

Thus, it will be seen, the patentee considered that he had made two separate inventions; but as they both related to the same subject matter, he obtained only one patent. The first of these inventions consists in "constructing the shoe of two parts in the peculiar manner described," in order to attain a particular result, namely, "so that the part in contact with the wheel can accommodate itself to the same." The second consists in the "peculiar combination" of the four elements of which it is formed. The specification throughout maintains this distinction announced in its first sentence, namely, that the patentee had made two separate and distinct improvements. To make this perfectly plain, we collate the parts of the specification describing them respectively.

First Improvement.—In regard to the first improvement,

the specification says: "A is the shoe, and B the sole, the "latter being formed to fit the periphery of the car wheel, (part "of which is shown by the line *x*), and having a lug *a* which "fits between the lugs *b b'* on the shoe. * *.

"It will be observed on reference to Fig. 2, that the lug *a* "is made tapering, and that the bolt G fits loosely in the said "lug as well as in the lugs *b* and *b'*, so that the sole is "self-adjustable laterally for a purpose described hereafter.

"A projection *d* on the sole B fits into a socket in the shoe in "such a manner that the sole can vibrate laterally in the said "socket, while the projection serves to maintain the shoe and "sole in their proper relative positions. * *

"The peripheries of car wheels are always beveled or in- "clined so that it becomes necessary to make the soles of the "ordinary shoes or rubbers of a corresponding bevel, one shoe "at one end of the beam being beveled in one direction, "and the other shoe at the opposite end of the beam being "beveled in a contrary direction.

"Even when the usual shoes are properly fitted to "the beveled peripheries of the wheels, the lateral move- "ment of the axles as the wheels traverse curves of "the track is such that the ordinary shoes cannot fit accurate- "ly at all times. Another evil attending the use of ordinary "shoes or rubbers is, that as the lateral movement of the axles "takes place, an undue strain is imparted to the brake beam.

"These difficulties are avoided by my invention, inasmuch as "the sole B is permitted to have a lateral rocking motion on "the shoe, and can at once accommodate itself to the bevel of "the wheel or to any variation caused in that bevel by the "lateral movement of the axle."

Second Improvement.—The second improvement is a combination of mechanism consisting of the shoe, sole, bolt and clevis; and, including the mechanical parts which also enter into the first combination, is thus described in the specification:

"A is the shoe, and B the sole, the latter being formed "to fit the periphery of the car wheel, (part of which is shown "by the line *x*), and having a lug *a* which fits between the "lugs *b b'* on the shoe.

"D is a clevis, the upper end of which is suspended to the "truck of the railway car, the lower end being arranged to "embrace the lugs *b* and *b'* of the shoe, a bolt G passing "through the lower end of the clevis, through the lugs *b* and "*b'* of the shoe, and through the lug *a* of the sole B."

After speaking at length of the invention involving the the rocking motion and its advantages, the specification recurring to the second improvement says:

"*Another improvement* in my invention is the peculiarly "simple arrangement of the clevis which supports the shoe, "the bolt G serving the purpose of connecting the clevis to "the shoe and the latter to the sole."

This is all the patentee says about his two inventions. In the first, it is manifest that constructing the shoe in two parts, so as "to give a lateral rocking motion," was the idea sought to be embodied in iron. In the second, the object aimed at was an easy and simple way of connecting all the parts and hanging the shoe. The simple combination of mechanism invented to accomplish this object, might or might not include a lateral rocking motion. That would depend on whether the parts were made loose in their bearings, and so far as regards this invention, the specification does not require them to be made either loose or tight. It says nothing whatever on the subject.

Carrying out the idea that he had made two improvements, one involving the "lateral rocking motion," and the other being a "peculiar combination" of mechanism, the patentee, consistently with his specification, sums up in two claims, as follows:

"Firstly—The shoe A and sole B, both being constructed "and adapted to each other substantially as described, so that

[illegible] extends up behind the bolt and

"the sole can have a lateral rocking movement on the shoe for "the purpose specified.

"Secondly—The combination of shoe A, sole B, clevis D, "and bolt G, the whole being constructed and arranged sub- "stantially as specified."

In reference to the manner in which the two inventions are treated in the specification and claims, Judge Drummond says: "It seems as though the patentee, in thus describing "his invention, intends two things. In the first place, to "describe the construction of the shoe and sole in such a way "that the latter is accommodated to the ordinary beveled per- "iphery of the wheel; and secondly, a combination of these "various parts, consisting of the shoe and the sole, the clevis "by which the shoe is suspended to the truck, and the bolt "which secures the clevis to the shoe, and the two parts of "the shoe to each other. And this intention of the patentee "seems to have been expressed in the claims."

If the rocking motion is an essential feature of the second claim, it must be so by construction. It is not comprehended in its language; there is not a word in the claim about it. Can it be injected by construction?

This second claim merely claims the combination of four pieces of iron, the shoe, sole, bolt and clevis; and as the patentee was the first to invent this combination, it seems a most unreasonable construction that he should not be fully protected in its use. And especially is this so if the language of his claim is susceptible of any construction that will give him such protection. Hence, even if there were any doubts as to the meaning of the claim, all such doubts should be resolved in appellee's favor.

As used in this claim, the words "shoe A, sole B," simply mean the mechanical parts, or pieces of iron, designated by these letters in the specification; and it certainly can not be said that either of these pieces of iron has any inherent

"lateral rocking motion". It is only when they are *adapted* to each other in the peculiar manner required by the first claim, that this motion is produced. But the second claim says nothing about such adaptation, and Judge Drummond seems to consider this very significant, for he says: "It will "be observed, the words are 'constructed and arranged', not "'adapted' as in the first claim."

The claim, in accordance with the usual practice, speaks of "the whole being constructed and arranged substantially as "specified." These words refer back to the specification, where the public are informed at length how the combination may be made; and where different improvements are claimed in the same patent, as in this case, such words merely refer to that part of the specification which describes the subject matter of the particular claim to which they are attached. Thus, in the first claim such words refer back to that part of Bing's specification which describes his invention having the "lateral rocking motion," while in the second they refer to the part which describes his "peculiar combination" of a shoe, sole, bolt and clevis.

Turning to the specification, then, a mechanic would find the description of two improvements, and that to embody them both in the same shoe, the parts must be made loose in their bearings. He would not find a statement to the effect that he *must* have the bearings loose in order to make the combination mentioned in the second claim. All that he would find in reference to this combination would be, that it consists of four pieces of iron, of certain shapes, when *connected* together in the particular way described.

To narrow this claim to cover only cases where the rocking motion, as well as the combination of mechanical parts, is found, appellant must show that either the specification or state of the art imperatively requires this construction in order to sustain the patent. If it cannot find such positive limitation in the specification, and we have shown that it cannot, then it must show that the same combination, *without* a rock

[illegible] measure extends up behind the bolt and

ing motion, existed prior to the invention. To save the patent, the Court might possibly then impose the limitation asked; but, as will presently appear, nothing even remotely the same has been shown. Neither the specification nor the state of the art, therefore, requires such a narrow construction.

That the patentee intended to keep his two improvements distinct and separate, so that he could be secured in the use of one without the other, we think is manifest from their division and distinct treatment in the specification. This view is confirmed by the fact that in one claim he seems to attach great importance to the rocking motion, while in the other he does not even mention this motion, but merely claims the *mechanical combination.* The silence of the second claim in regard to the rocking motion, clearly indicates the intention of the patentee, as well as the construction which the examiner gave to the language used in claiming the inventions. If the rocking motion was to be a feature of the second claim, why was it not so stated? and why was it not mentioned in the description of the invention "secondly," in the opening part of the specification?

But appellant contends that the only novelty of Bing's invention is in the rocking motion, and that this really constitutes the essence of the invention; and hence, that on the construction here contended for, the patent is void as to its second claim. This is manifestly a mistake.

That the rocking motion is not the only valuable feature of the invention is conclusively shown by the fact, that a large number of railroads, including appellant, are now using brake shoes which are claimed not to have any rocking motion, but which, in mechanical construction, are the same as the patented shoe. This judgment of railroad men, thus unmistakably expressed, clearly shows that the mechanism, as well as the rocking motion, should be considered a valuable and important part of the invention.

The essence of the patentee's invention, then, is in his me-

chanical combinations, as well as in his rocking motion. As said by Judge Drummond, "his invention is the peculiar con-"struction of the shoe in these two parts, put together and "separated in the way described."

In fact, considering the state of the art, Bing was entitled to much broader claims than those contained in the patent. He was entitled to at least two other claims, neither of which should have included the rocking motion or clevis, and in one of which he should have been protected in the use of the shoe and sole alone, and in the other in the use of the shoe, sole and bolt, when combined in the manner described. These claims should have been as follows: First, the combination of shoe A and sole B, substantially as described; and second, the combination of shoe A, sole B and bolt G, substantially as described. As will appear presently, these claims would have been valid, as to novelty, over all previous inventions.

In this view, appellee certainly has very strong claims to ask a construction that will protect it in the use of the mechanical combinations described, to the fullest extent allowed by the language of the patent. Instead of permitting appellant to escape, then, on any narrow or technical construction, the Court should endeavor to give appellee the benefit of the actual invention, to the full extent claimed.

Judge Drummond, holding that no rocking motion is required by the second claim, thus clearly and forcibly states the question, and the true construction to be given to the patent:

"The question is, whether there is necessarily found in the "second claim and as an essential part of it, without which it "does not exist as a valid claim and there can be no infringe-"ment, the peculiar construction of parts which produce the "rocking motion. This claim is: 'The combination of shoe "'A, sole B, clevis D, and bolt G, the whole being constructed "'and arranged substantially as specified.' It will be ob "served, the words are '*constructed and arranged*,' "not 'adapted,' as in the first claim; and the rocking motion

"is not a part of the claim unless implied by the language "used.

"I am inclined to think there may be an infringement, and "this may be a valid claim, independent of what is set forth "in the specification as he describes the invention, 'firstly,' "and in the first claim, without its possessing the rocking "motion; and, therefore, that the view which the plaintiff's "counsel take of the construction of the patent is correct.

"I have already called attention to the manner in which "the inventor divides his invention into two parts—first, so "that the sole can accommodate itself to the periphery of the "wheel, and secondly, the peculiar combination of the two "parts of the shoe, the clevis by which the shoe is suspended "upon the truck, and the bolt which secures the clevis to the "shoe, and the two parts to each other; and also, to that part "of the specification in which he says that the difficulties "which have heretofore existed, are avoided because of the "shoe having this lateral rocking motion. He then says, his "invention or device has *another improvement*, and that "consists in what he describes 'secondly,' as his invention, "in the first part of his specification—the peculiarly simple ar- "rangement of the clevis which supports the shoe, the bolt G "serving the purpose of connecting the clevis with the shoe, "and the latter to the sole

"Whether or not the combination of the second claim con- "tains, as an essential element, this lateral rocking motion, in "order to make it a valid claim, and whether it must be found "in an infringing machine, is the question. If this rocking "motion was all that was in the mind of the inventor, I think "it may be asked, with a good deal of significance, what was "the necessity of his dividing his invention into two parts, "as he did in his specification, and also in the claims. He "may have had in his mind that the device which he was des- "cribing, was constructed in the way which he has specified; "but still he claims a combination, which he describes in his "second claim, and I think it may be a valid combination, in-

"dependent of the lateral rocking motion, which he speaks of "in the first claim, and in various parts of the specification. "If it is not so, then all that would be necessary to prevent "infringement would be to change slightly the form of the lug "(*a*) of the sole, or to tighten the bolt G."

But appellant claims that, under this construction, there is no merit in the invention, but that it is really a step backwards, and more inconvenient in arrangement than previous devices. If this be true, it is a somewhat singular fact that many leading railroads have adopted, and continued to use, this "inconvenient" construction, a large number of which are admitted to be now using the exact shoes here claimed to be infringements. Certainly, this is sufficient proof of the utility of the invention

If this construction of the second claim, contended for by appellee, and adopted by Judge Drummond, namely, that the rocking motion mentioned in the first claim forms no part of the second, be correct, it remains to consider

THE QUESTION OF INFRINGEMENT.

Under this construction, appellant concedes that the first of its brake shoes is an infringement. In the fifth paragraph of the stipulation of facts, it is admitted "that the first of said "brake shoes is constructed *in all respects* like that described "in said patent, except that the two parts, viz., the shoe and "the sole are fitted to each other so snugly as to have no "rocking motion." And in the tenth paragraph it is stated as follows: "That if the Court be of the opinion that said "lateral rocking motion forms no part of the second claim of "said patent, then the first of said defendant's brake shoes "above mentioned is admitted to be an infringement of said "claim, and the decision as to that shoe shall be in favor of "complainant; provided, the Court shall also be of the opinion "that there is, on that construction, any patentable novelty in "said claim."

The mechanical construction of this shoe being thus admitted to be the same as that of the shoe described in appellee's patent, no model of it is now presented.

As to the second of its brake shoes, which is represented by the model marked "Defendant's Exhibit B," appellant insists that its mechanical construction is substantially different from the combination secured by Bing's second claim, and that even under Judge Drummond's construction such shoe is not an infringement.

This brake shoe has a shoe provided with two lugs or ears at the top, and a socket near the bottom. The sole has a lug at its upper end, adapted to fit between the two lugs of the shoe, and is provided with a cylindrical shaped projection near its lower end, to fit in the channel-shaped socket near the bottom of the shoe. The lug *a* on the sole has a spur or projection in an upward and outward direction, so that its upper edge forms, as it were, the half of a hole, adapted to partially surround and embrace a bolt which passes through the two lugs of the shoe, and immediately above the lug on the sole. The clevis, or hanger for the brake beam, is a strap of iron about an inch and a half in width, which is bent round the bolt between the two lugs of the shoe, there being sufficient space between the lug on the sole and the bolt to permit this.

The points of resemblance between this shoe and the patented device are, that both have shoes with two lugs at the top extending in a vertical direction; in both, the shoes have sockets near the bottom, to receive a projection on the sole; in both, the shoes are scalloped out to form a space between the shoe and sole; in both, the shoes have a seat or shoulder between the two lugs, on which the lug of the sole rests, and which supports the weight of the sole; in both, the sole has a lug to fit between the two lugs of the shoe; in both, the sole has a projection near its bottom, which fits into the corresponding socket on the shoe, and "serves to maintain the shoe

"and sole in their proper relative positions;" in both, the bolt serves to prevent the sole from falling out or forward; in both, it secures the clevis or hanger to the shoe, and the two parts of the shoe to each other. These resemblances are so many and so striking, that the paternity of appellant's shoe is manifest. Without question, its origin was Bing's invention.

The shoe, as a whole, differs from the patented device in the immaterial features that its three lugs are somewhat differently shaped; that the bolt passes just above instead of through the lug on the sole, and that the clevis, instead of embracing the lugs of the shoe, fits between them. These differences are less material than we usually find where a party has taken a valuable invention, and while appropriating the benefits, sought to escape the penalties of the infringement.

That these changes require only the most ordinary mechanical skill, we think will be apparent upon the most casual examination. They produce no new result. They are no improvement. They operate precisely as in the patented device, to effect precisely the same purpose. The clevis strap suspends the shoe and brake beam to the car truck, the same as if it were U shaped and embraced the lugs. The bolt "secures the clevis to the shoe, and the two parts of the shoe to each other.' as fully and as truly as if it passed directly through the three lugs, instead of above one of them.

It is, however, insisted by appellant that the sole is not retained in place by the bolt, but that the bolt holds the clevis, and the clevis holds the sole! As well might it insist that the first link in a chain suspending a weight alone sustains the strain, and that the others do not contribute their part.

That the sole *is* retained in place by the bolt is shown by the fact that it cannot be removed until the bolt is withdrawn and the clevis detached. That the sole is *intended* to be retained by the bolt, is shown by the peculiar formation of its upper lug, which in a measure extends up behind the bolt and

clevis, so as to partially surround and embrace them. That the clevis, and not the bolt, rests against the lug, can make no difference, as it is still the bolt which holds the clevis against the lug and secures it. Remove the bolt, and the clevis is powerless to retain the sole or anything else.

It is plain then, that the bolt and clevis perform the same office, respectively, in the brake shoe represented by the model, "Defendant's Exhibit B," as in the combination described and secured in Bing's second claim. All the differences are mechanical, or. in the words of Judge Drummond, "the variations are not substantial, but are more in form than "in substance."

It is insisted, however, that appellee cannot invoke the doctrine of mechanical equivalents, because no proof has been offered to show "that the parts substituted by the defendant in "place of those shown in the patent, were well known as pro-"per substitutes therefor at the date of Bing's invention." Our answer to this is, that no doctrine of mechanical equivalents has any application to this case. No parts are substituted in appellant's shoe, model Exhibit B; but exactly the same parts are used as in the patented invention, namely, a shoe, a sole, a bolt, and a clevis or hanger. That some of these parts are slightly different in form from those shown in the patent, can make no difference. For instance, notwithstanding the form of its lugs, the sole of appellant's shoe *is a sole*, and not something else substituted in the place of Bing's sole; and, in effect, the same may be said of all the other parts.

PRIOR INVENTIONS.

As a last hope, appellant insists that, under Judge Drummond's construction, the combination mentioned in Bing's second claim is wanting in patentable novelty. This position is so manifestly erroneous that, with all deference to counsel, we cannot believe it possible for this Court to even give it serious consideration. The record shows such a wide difference between the patented invention and the principal prior

device relied upon by appellant, that we deemed it unnecessary to make any reference to such device, in considering the construction that should be given to appellee's patent; for, in our view, it cannot operate to limit the invention further than the patentee's own specification and claims.

This prior device is represented by the model "Defendant's Exhibit C," and has been selected, as the nearest approach to the patented invention, from a large number used in the Court below. The brake shoe represented by this model is thus described in appellee's admission in regard to its prior use, in the seventh and eighth paragraphs of the stipulation of facts:

"That brake shoes having a detachable sole attached to the "shoe, by two bolts passing through the shoe and sole, at "right angles to the face of the sole, one at the top and one at "the bottom, and secured by nuts screwed on to the inner "ends of said bolts, so that the sole could be taken off upon "the removal of both of said bolts, had been known and used "in the United States for some years prior to the said inven- "tion of said Bing. * * That said shoe last men- "tioned was suspended from the truck by a hanger or clevis "attached to a bolt passing through a hole at the top of said "shoe, as shown in said model."

The construction of this brake shoe, and the manner of its suspension, are apparent on an inspection of the model C.

The bolt attaching the hanger to the shoe performs no other office. It does not "secure the clevis to the shoe, and the two parts of the shoe to each other." It does not contain the characteristic of the invention secured by the second claim, which the patentee describes as "the peculiarly simple ar- "rangement of the clevis which supports the shoe, the bolt G "serving the purpose of connecting the clevis to the shoe, "and the latter to the sole." It is lacking in this feature, which both of defendant's shoes contain in common with the patented device, to say nothing of its general clumsy construction and marked difference from the patented combination in other important respects.

At the hearing in the Court below, appellant introduced seven prior patents, to show the state of the art at the time of Bing's invention, one of which described the brake shoe represented by the model "Defendant's Exhibit C." Speaking of these patents, Judge Drummond says:

"I do not understand that in the various patents that have "been put in evidence, there is anything which successfully "attacks the device invented by the patentee, and which "would prevent it from taking effect as the subject of a valid "patent. It is true, before this invention there were devices "by which the two parts of the shoe were separated when "that which was applied to the periphery of the wheel was "worn out, or so worn that it could be no longer successfully "used; but after all, that is not the invention of the patentee "in this case. His invention is the peculiar construction of "the shoe in these two parts, put together and separated in "the way described."

Appellant also refers to the common slate frame, fire tongs, carpenter's rule, draughtsman's compass, "and a hundred other things equally familiar,' —none of which is mentioned in the stipulation of facts. It is not believed that these references can have any effect on the patented invention—first, because none of them has the clevis, or any part corresponding to the clevis, which forms an element in Bing's combination (*Bates* v. *Coe*, 98 U. S. 48); second, because none of them shows Bing's construction and fitting together of parts, which forms an important feature of the invention, and in which there is abundant novelty to support the claim; and, third, because the purposes for which they were used were entirely different. and analogous to that of the patented invention.

Considering the state of the art, we submit that Bing's position in this field of invention entitles his patent to the most liberal construction his claims will allow. Appellant has brought into the case all that could be found to show the state of the art, and limit the patent, but it has not been able

to show anything even remotely similar to the patented device. The previous inventions relied on wholly fail to show the peculiarly simple combination of parts forming the patented invention.

So great has proved the utility of the patented invention, that it has come into most extensive use; and it may now be seen, specifically or in slightly modified forms, on almost all the railroads in the United States. No better evidence of the advance in the art made by Bing's invention could possibly be produced than the crude and clumsy device introduced by appellant, and which the patented shoe has largely displaced. We submit that a survey of what preceded the patentee can only increase respect for the merit and utility of his invention, and show that the most liberal construction consistent with the language used should be now given to his claims.

Appellee submits that the decree of the Court below should be affirmed in all respects.

Respectfully submitted,

EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Appellee.